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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/609,038	06/30/00	OCHS	M 10064-1U1-(2)

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EXAMINER

WOODWARD, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 10/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/609,038

Applicant(s)

OCHS ET AL.

Examiner

Michael P Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-93 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 2, drawn to a computer implemented process of pattern identification, classified in class 382 subclass 128.
- II. Claims 1 and 3, drawn to a computer implemented process of pattern identification, classified in class 382, subclass 128.
- III. Claims 1 and 4-8, drawn to a computer implemented process of pattern identification involving spectral shapes, classified in class 382, subclass 133.
- IV. Claims 1 and 9, drawn to a computer implemented process of pattern identification of chemical species, classified in class 702, subclass 22.
- V. Claims 1, 10-12, drawn to a computer implemented process of pattern identification of mRNA in time using derived DNA, classified in class 382, subclass 129 and or class 702 subclass 32.
- VI. Claims 1, 10, 13-16, drawn to a computer implemented process of pattern identification of mRNA in time using cDNA, classified in class 382, subclass 129 and or class 702 subclass 32.
- VII. Claims 1, 10, 17 and 18, drawn to a computer implemented process of pattern identification of mRNA in time using PCR, classified in class 382, subclass 129 and or class 702 subclass 32.
- VIII. Claims 1, 10 and 19-22, drawn to a computer implemented process of pattern identification of mRNA in time using an array, classified in class 382, subclass 129 and or class 702 subclass 32.
- IX. Claims 1 and 23-25, drawn to a computer implemented process of pattern identification mRNA in space using derived DNA, classified in class 382, subclass 129 and or class 702 subclass 32.

- X. Claims 1, 23 and 26-29, drawn to a computer implemented process of pattern identification mRNA in space using cDNA, classified in class 382, subclass 129 and or class 702 subclass 32.
- XI. Claims 1, 23, 30 and 31, drawn to a computer implemented process of pattern identification mRNA in space using PCR, classified in class 382, subclass 129 and or class 702 subclass 32.
- XII. Claims 1, 23 and 32-35, drawn to a computer implemented process of pattern identification mRNA in space using an array, classified in class 382, subclass 129 and or class 702 subclass 32.
- XIII. Claims 1 and 36-38, drawn to a computer implemented process of pattern identification of DNA in individuals using cDNA, classified in class 382, subclass 129 and or class 702 subclass 32.
- XIV. Claims 1, 36, 39 and 40, drawn to a computer implemented process of pattern identification of DNA in individuals using derived DNA, classified in class 382, subclass 129 and or class 702 subclass 32.
- XV. Claims 1, 36 and 41-43, drawn to a computer implemented process of pattern identification of DNA in individuals using amplification, classified in class 382, subclass 129 and or class 702 subclass 32.
- XVI. Claims 1, 36 and 44-47, drawn to a computer implemented process of pattern identification of DNA in individuals using an array, classified in class 382, subclass 129 and or class 702 subclass 32.
- XVII. Claims 1 and 48-50, drawn to a computer implemented process of pattern identification of DNA in a specific location using cDNA, classified in class 382, subclass 129 and or class 702 subclass 32.
- XVIII. Claims 1, 48, 51 and 52, drawn to a computer implemented process of pattern identification of DNA in a specific location using derived DNA, classified in class 382, subclass 129 and or class 702 subclass 32.

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- XIX. Claims 1 and 48 and 53-55, drawn to a computer implemented process of pattern identification of DNA in a specific location using amplification, classified in class 382, subclass 129 and or class 702 subclass 32.
- XX. Claims 1, 48 and 56-59, drawn to a computer implemented process of pattern identification of DNA in a specific location using an array, classified in class 382, subclass 129 and or class 702 subclass 32.
- XXI. Claims 1 and 60-62, drawn to a computer implemented process of pattern identification of DNA in time and expression in time using cDNA, classified in class 382, subclass 129 and or class 702 subclass 32.
- XXII. Claims 1, 60 and 63-67, drawn to a computer implemented process of pattern identification of DNA in time and expression in time using derived DNA, classified in class 382, subclass 129 and or class 702 subclass 32.
- XXIII. Claims 1, 60 and 68-71, drawn to a computer implemented process of pattern identification of DNA in time and expression in time using an array, classified in class 382, subclass 129 and or class 702 subclass 32.
- XXIV. Claims 1 and 72-77, drawn to a computer implemented process of pattern identification of chemical mixtures using IR spectra, classified in class 702, subclass 22.
- XXV. Claims 1, 78 and 79, drawn to a computer implemented process of pattern identification goods or services in time, classified in class 382, subclass 190.
- XXVI. Claims 1, 78 and 80, drawn to a computer implemented process of pattern identification goods or services in space, classified in class 382, subclass 182.
- XXVII. Claims 1 and 81, drawn to a computer implemented process of pattern identification of creating matrix D, classified in class 382, subclass 128.
- XXVIII. Claims 1, 82 and 83, drawn to a computer implemented process of pattern identification employing entities in space, classified in class 382, subclass 182.
- XXIX. Claims 1, 82 and 84, drawn to a computer implemented process of pattern identification employing entities in time, classified in class 382, subclass 182.

- XXX. Claims 1 and 85, drawn to a computer implemented process of pattern identification wherein the data matrix involves counting number of occurrences, classified in class 382, subclass 182.
- XXXI. Claims 1 and 86, drawn to a computer implemented process of pattern identification wherein the data matrix is a set of spatially dependent functions, classified in class 382, subclass 181.
- XXXII. Claims 1, 87 and 88, drawn to a computer implemented process of pattern identification wherein the original data matrix is a series of images acquired at different wavelengths, classified in class 382, subclass 181.
- XXXIII. Claims 1, 87 and 89, drawn to a computer implemented process of pattern identification is a series of images acquired at different times, classified in class 382, subclass 181.
- XXXIV. Claims 1 and 90, drawn to a computer implemented process of pattern identification wherein the data arise from behavioral studies, classified in class 382, subclass 182.
- XXXV. Claims 1 and 91, drawn to a computer implemented process of pattern identification wherein the data arise from clinical studies, classified in class 382, subclass 182.
- XXXVI. Claims 1 and 92, drawn to a computer implemented process of pattern identification wherein the data arise from biomedical studies, classified in class 382, subclass 182.
- XXXVII. Claims 1 and 93, drawn to a computer implemented process of pattern identification wherein the data arise from psychodynamic studies, classified in class 382, subclass 182.

The inventions are distinct, each from the other because of the following reasons:

Groups I through XXXVII are linked through claim 1, in addition claims 10, 23, 36, 48, 60, 78, 82 and 87 are considered linking claims. Claim 1 sets forth a general analytical method absent description of the data subject to analysis whereas each of claims 10, 23, 36, 48, 60, 78,

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82 and 87 describes a specific subject area from which data are obtained. Each subject area concerns an unrelated area of investigation. Within each specifically disclosed subject area there are separate inventions which relate to the actual manner in which data are generated. The data generation methods and applicability of the data within the context of the subject area are unrelated amongst themselves. In addition to the search with respect to image analysis there is an additional search for the methods of chemical analysis within classes 435, 436 and 422 depending upon the particular subject matter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

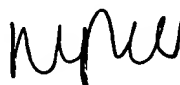
Because these inventions are distinct for the reasons given above and the search required for each of Groups I-XXXVII is distinct, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

It is noted that applicant has not filed an information disclosure statement. The examiner would greatly appreciate copies of the references cited in the specification and any other documents which applicant reasons would facilitate the examination process of the instant application.

Any inquiry concerning this communication should be directed to Supervisory Patent Examiner Michael P Woodward at telephone number 703-308-4028.


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